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| 10/743,671  | 12/24/2003  | Kia Silverbrook      | NPB008US                | 7891                   |
| 24011 7590 02/14/2008<br>SILVERBROOK RESEARCH PTY LTD<br>393 DARLING STREET<br>BALMAIN, 2041<br>AUSTRALIA |             |                      |                         |                        |
|   |             |                      | EXAMINER<br>LE, KHANH H |                        |
|   |             |                      | ART UNIT<br>3622        | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/743,671

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

KHANH H. LE

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. This Office Action is responsive to the Correspondence filed November 28, 2007. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/2007 has been entered.
2. Claims 1-4, 8-11 are now pending (with claims 8-11 withdrawn). Claims 1-4 now examined. Claim 1 is amended. Claim 1 is independent.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
5. Claim 1: step f): "said human readable information" lacks antecedent basis. Claims 2-4 are rejected as dependents of claim 1.

### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**7a. Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 7271931 in view of Dymetman US 6330976 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 3 of U.S. Patent No. 7271931 reads as follows:

*1. A method of generating a printed interactive document, said document comprising graphical information for a user and coded data identifying the document and a plurality of locations on the document, said method comprising the steps of:*

*(a) allocating and recording a document identity in a computer system;*

*(b) determining a page description for the document in the computer system, said page description comprising a description of graphical information and a description of an interactive element which includes a zone of the interactive element on the document;*

*(c) associating the document identity with the page description in the computer system;*

*(d) sending at least part of the page description and the document identity to a printer networked with the computer system, thereby enabling the printer to generate the coded data and print the document onto a substrate.*

*2. The method of claim 1, wherein the printed document enables a user to request a further copy of at least one page of the document.*

*3. The method of claim 2, comprising the further steps of: receiving, in the computer system, indicating data from a sensing device operated by a user, said indicating data identifying the document and a position of the sensing device relative to the document; identifying, in the computer system and with*

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*reference to the zone of the interactive element, a request for a copy of at least one page of the document; sending, from the computer system to a printer, document data based on the a description of the at least one page requested.*

Current claim 1 has all the limitations of claim 3 of U.S. Patent No. 7271931 except current claim 1 also have page description including type of the interactive element. However Dymetman US 6330976 discloses page description including type of the interactive element (col. 24 lines 4-12: i.e. the type is a hyperlink). It would have been obvious to one skilled in the art at the time the invention was made to add such element taught by DYMETMAN to claim 3 of U.S. Patent No. 7271931 to determine what kind of action to take when many types of actions may be involved.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**7b. Claims 2 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 7271931 in view of Dymetman US 6330976 and further in view of Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406 ( herein "Intelligent Paper").**

Claims 2 and 4:

DYMETMAN does not disclose but Intelligent Paper teaches the associated entity is a publisher or its computer system (e.g. page 393: owner of the Paris map content). It would have been obvious to one skilled in the art at the time the invention was made to add such publisher to claim 3 of U.S. Patent No. 7271931 and Dymetman to effect the application disclosed in Intelligent Paper.

**7c. Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7175079 in view of Dymetman, Ur and Intelligent Paper since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

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Claim 1 of U.S. Patent No. 7175079 reads:

1. *A method of enabling online purchasing via a form printed on a substrate, said form including graphical purchasing information and a plurality of tags, each tag comprising coded data identifying the form and its own location on the form, the method including the steps of:*

*(a) determining a unique page identity for said form in a computer system before printing said form;*

*(b) determining a page description for said form in said computer system before printing said form, said page description comprising a description of graphical information on said form, and a description of an interactive element including a zone of said interactive element on said form;*

*(c) associating said page identity with said description of said interactive element;*

*(d) printing, on demand, the form onto a substrate using a printer networked with the computer system, said graphical information and said tags being printed at the same time;*

*(e) receiving, in said computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, generating the indicating data using at least some of the coded data; and (f) identifying, in the computer system and from the indicating data, at least one parameter relating to the purchasing transaction.*

Current claims 1-4 differ from claim 1 of U.S. Patent No. 7175079 only by the latter claiming printing on demand, a description of a zone, and a purchase transaction. These limitations are taught respectively by either DYMETMAN, Ur or Intelligent Paper as explained below in the 35 USC 103(a) discussion. Thus it would have been obvious to a PHOSITA to add these elements to claim 1 of U.S. Patent No. 7175079 to achieve the purposes taught in DYMETMAN, Ur or Intelligent Paper as discussed below.

**7d. Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Publication No. US 20070269110 in view of Dymetman, Ur and Intelligent Paper since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

Claim 1 of U.S. Patent Publication No. US 20070269110 reads:

*1. A method of distributing, via a computer network, a periodical comprising at least one printed page, said printed page comprising graphical information functioning in cooperation with a plurality of coded data tags to provide at least one interactive element, said interactive element enabling user interaction with the page using an optical sensing device, said method including the steps of: (i) determining a unique page identity for said page in a computer system; (ii) determining a page description for said page in said computer system, said page description comprising: (a) description of said graphical information, and (b) a description of said interactive element, said description of said interactive element including: (b1) a zone of said interactive element on said page and (b2) an identifier for said interactive element; (iii) associating said page identity with said description of said interactive element; and (iv) sending the page identity and the description of said graphical information to a printer via the computer network, thereby causing the printer to generate the plurality of coded data tags using the page identity and to print the page, wherein each coded data tag contains a code pattern identifying the page identity and the tag's own location on said page.*

Current claims 1-4 differ from claim 1 of U.S. Patent Publication No. US 20070269110 only by the latter claiming a periodical tags, optical device, a description of a zone. These limitations are taught respectively by either DYMETMAN , Ur or Intelligent Paper as explained below in the 35 USC 103(a) discussion. Thus it would have been obvious to a PHOSITA to add these elements to claim 1 U.S. Patent Publication No. US 20070269110 to achieve the purposes taught in DYMETMAN, Ur or Intelligent Paper as discussed below. Also it would have been obvious to a PHOSITA too that a periodical would be a likely extension of the e-commerce possibilities taught by DYMETMAN and/or Intelligent Paper.

**7e. Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent Publication No. 20060218099 in view of Dymetman, Ur and Intelligent Paper since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

Claims 1- 4 of U.S. Patent Publication No. 20060218099 read:

*1. A method of enabling a purchasing transaction via a printed interactive form, said form having printed thereon graphical information relating to a purchasing transaction and a plurality of tags, each tag containing coded data identifying said form and its own location on said form, said method comprising the steps of: a computer system receiving indicating data from an optically*

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*imaging pen interacting with said form, said indicating data comprising data regarding an identity of said form and data regarding a location of said pen relative to said form, said pen generating said indicating data using sensed coded data, and said computer system identifying at least one parameter relating to said purchasing transaction using said indicating data.*

*2. The method of claim 1, wherein said computer system causes said form to be printed at a printer networked with said computer system.*

*3. The method of claim 2, wherein said computer system causes said form to be printed by the steps of: determining a unique page identity for said form in said computer system; determining a page description for said form in said computer system, said page description comprising: (i) a description of said graphical information and (ii) a description of an interactive purchasing element, which includes a zone of said interactive purchasing element on said form; and transmitting page identity data and data regarding said graphical information from said computer system to said printer.*

*4. The method of claim 3, further comprising the step of printing said form using said printer, wherein said printer generates dot data for said tags using said page identity data.*

Current claims 1-4 differ from claim 4 of U.S. Patent Publication No. US 20060218099 only by the latter claiming a form, tags, optical device, purchase transaction. These limitations are taught respectively by either DYMETMAN, Ur or Intelligent Paper as explained below in the 35 USC 103(a) discussion. Thus it would have been obvious to a PHOSITA to add these elements to claim 1 U.S. Patent Publication No. US 20060218099 to achieve the purposes taught in DYMETMAN, Ur or Intelligent Paper as discussed below. Thus it would have been obvious to a PHOSITA too that a form would be a likely extension of the e-commerce possibilities taught by DYMETMAN and/or Intelligent Paper.

### **Claim Rejections - 35 USC § 103**

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman US 6330976 in view of Ur, US 6072871.**

**Independent claim 1:**

DYMETMAN discloses:

A method and system for providing content in a printed document or publication and for tracking user interaction with an input element on the printed publication, the method (abstract, Figs. 1 and 2 and associated text) comprising the steps of :

- a) determining a unique page identity for said publication (page or document) in a computer system (unique "code page-id" for each page; Fig. 2, " pid " and associated text);
- (b) identifying visible layout and content for said publication (e.g. Fig. 4 and associated text: map 104 is content as well as a layout);
- (c) determining and storing a page description for said publication in said computer system, said page description describing the visible layout and content (col. 23 line 10 to col. 24 line 19: discussion of digital pages as corresponding to physical pages when active regions on a physical page is activated- col. 23 lines 46-50. Storage of a page description of the digital page such as for map 104 in Figure 4 above is inherent so to render the page. Also see col. 29 lines 53-55; 59-60; col.30 lines 44-47: discussion of page description formats that can be used) and type (col. 24 lines 4-12: i.e. the type is a hyperlink) and zone of said input element (col. 23 lines 51-67: description of a " region")
- (d) associating said page identity with said description of said input element (associating the pid of the physical page to description of the input element, see Figures 2, 12 and 13 and associated text; citations above and excerpt below (emphasis added))

*Detailed Description Text - DETX (177):*

*A digital page receives the position of the pointer, and must determine if that position is within an active region. To this end, it can have a description of the active regions on the page.*

*Detailed Description Text - DETX (178):*

*Rectangular regions have a particularly simple description. Given two diagonally opposing corners of a rectangle, a digital page can determine whether a given point lies within it or not, and the function used to tell is also particularly simple.*

*Detailed Description Text - DETX (179):*

*Arbitrarily complex regions can be described in such a manner that a digital page can determine whether a given point lies within it. The function needed to decide may be complex, and different types of descriptions require different functions. We will call a pair consisting of a description of a region and a function to decide whether a point lies in it a "region".*

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*Detailed Description Text - DETX (181):*

Once the digital page has determined that a position is within an active region, it can cause an action (or a number of actions) to be executed. For this purpose, it can have a description of the action(s) for that region.

...

*Detailed Description Text - DETX (212):*

An Add Action box would function in a very similar manner, the difference being that the digital page would not automatically interpret the data it gets from the dialog box as a URL. Instead, the user must provide a complete description of the action. For example, assuming actions are described as type, data pairs, the user could select the type from a menu and enter the data. A type "Program" that launches a program would provide a catch-all to allow virtually any type of action to be added.

DYMETMAN also teaches wherein the storing step (c) is performed before the printing step h): DYMETMAN discloses at (col. 9 lines 58-60) a "[D]igital page 6 may be a digital representation (e.g. a Web page) of the printed, human-readable information in document 2, a representation that can be displayed or printed."

This implies determination and storage of the digital page description has to occur before printing of the physical page in order to render the corresponding physical page upon user request by clicking.

(In the alternative, or in addition the implication above, storing an immutable layout including a zone of the interactive element (see bolded excerpt below) of a digital representation (e.g. a Web page) of a printed, document is old art, cited by DYMETMAN, as below:

*"Robinson, P., Sheppard, D., Watts, R., Harding, R., and Lay, S., "A framework for interacting with paper", EUROAGRPHICS '97, Vol. 16, No. 3, 1997, pp. C-329 to C-334, describe a framework for preparation and presentation of mixed-media documents using a registry that associates physical locations on pieces of paper with actions. A DigitalDesk, which has a video camera mounted above a desk to detect where a user is pointing and to read documents on the desk and a projector mounted above the desk to project objects onto the work surface and paper documents, is used to identify pieces of paper and animate them by placing them on the DigitalDesk. The camera identifies the document and follows the pointer, and associated actions are identified in the registry and invoked as appropriate with the results being projected back onto the paper. To identify a document, a page is marked with a unique OCR font identifier that encodes the location of the directory as a network IP address and an index for the document within the directory. **A document can be printed from the registry, with its unique identifier; a printed document's page***

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*representation is retained in the registry as an immutable copy of its structure. Paper access to the World Wide Web is possible. Given a URL, information on the associated web page can be captured in the registry, the page can be printed, and links can be activated by placing the paper on a DigitalDesk and pointing. The page's identifier and the coordinates of the link are looked up in the registry to yield the appropriate activity, and the results are projected back onto the desk.*

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to add such digital page description to DYMETMAN to allow robust rendering of the printed page from the digital page and to allow look-up of the interactive element coordinates from the stored description as taught by Robinson above. )

**(e)-(h) : see below**

(i) receiving, (in a computer system), from a sensing device, indicating data indicative of a position or movement of the sensing device relative to the printed publication said indicating data being generated by the sensing device using sensed coded data (Figures 2, 12, 23 and associated text, using the pair: code page-id, pointer-loc);

(j) identifying from the indicating data (data derived from interacting with the pair code page-id -pointer-loc, see Fig 2 and associated text) and the page description containing a description of the zone of the input element (col. 23 lines 51-67: description of a "region") whether the user has selected the input element using the sensing device

(from detecting interaction with pair: code page-id, pointer-loc and mapping it (col.23 lines 66-67) to the: description of a "region", col. 23 lines 51-67), and if so notifying an associated entity of the selection (Dymetman) discloses sending information after request from a user interacting with the input element over a computing system (excerpt below): notification to associated party is implied when digital page is accessed (see Fig 12 and excerpt :

*"Detailed Description Text - DETX (121):*

*In the first box in FIG. 12, the processing circuitry initializes memory locations at which it can store two network addresses, an address for a peripheral device to which output can be sent and an address of a digital page. As illustrated, the processing circuitry then performs a series of iterations, each of which begins when a user clicks. "* )

**Printing Steps (e)-(h):**

DYMETMAN teaches printing both coded and human readable data, (col. 13 lines 45-57; pair: code page-id, pointer-loc the coded data being invisible; coded data on surface of paper).

*FIG. 4 illustrates components of a document printed on a coded substrate.*

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*Printed document 102 comprises layer 104 of printed visible (human-readable) information, i.e. document content, printed on coded substrate 106, illustratively a segment of a map though layer 104 could include text, photographic images, or any other human-readable information. The coded substrate 106 in turn comprises a layer 108 of visible or invisible machine-readable marking sprinted on a sheet medium 110 (e.g. paper).*

Thus DYMETMAN also discloses a method for printing a publication including:

(e) generating, in a printer, first dot data for coded data using said page identity, said coded data identifying said page identity and a plurality of positions on said publication ( above excerpt and also see col. 13 lines 45-57; pair: code page-id, pointer-loc);

(f) generating, in a printer, second dot data for said human-readable information using at least part of said page description ( above excerpt and e.g. col. 23 line 47-49 : "words");

**However, DYMETMAN does not disclose printing both types of data, simultaneously. That means DYMETMAN does not disclose:**

(g) compositing the first and second dot data; and

(h) printing the publication wherein the coded data is printed at the same time as printing the human-readable information using the composited dot data.

**However Ur discloses:**

generating in a printer first dot data for coded data (Fig 2 item 27: coded data; col. 4, lines 41-47)

generating second dot data for human-readable information (Fig 2 item 23: human-readable data)

g) compositing the dot data in a printer prior to printing (col.4 lines 15-18: instructions for printing in the printer, allowing printing both types of data simultaneously, **col. 4, lines 41-47**, read on "compositing" );

h) printing interactive publications (col. 4 lines 30-34: interaction with scanners) **on demand** (col. 4 lines 1-3) with human-readable information and coded data being printed at the same time (**col. 4, lines 41-47**). (This reads on "wherein the coded data is printed at the same time as printing the human-readable information using the composited dot data").

**Since DYMETMAN teaches printing both types of data (visible and coded) it would have been obvious to one skilled in the art at the time the invention was made to add the Ur's teaching of printing simultaneously both, to DYMETMAN , to allow faster printing. In view of the level of skill evident in the references, one of ordinary skill, at the time of the**

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**invention, would have known to combine the technologies disclosed to produce the claimed invention.**

**Claim 3:**

DYMETMAN also teaches the input element is a hyperlink ( "clicks"-- throughout the reference --connotes a hyperlink; (e.g. col. 23 line 47-49 : " highlighted words");).

**10. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman, in view of Ur, and further in view of "Intelligent Paper" .**

**Claims 2 and 4:**

DYMETMAN does not disclose but Intelligent Paper teaches the associated entity is a publisher or its computer system (e.g. page 393: owner of the Paris map content). It would have been obvious to one skilled in the art at the time the invention was made to add such publisher to DYMETMAN and Ur to effect the application disclosed in Intelligent Paper.

**Response to Arguments**

11. In view of the amendment a more detailed disclosure by Dymetman now replaces "Intelligent Paper" (Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406) used earlier.

As the present reference discloses at least the same material as Intelligent Paper, all previous discussion pertaining to Intelligent Paper is herein incorporated by reference.

Applicant's extensive arguments against Intelligent Paper as non-enabling reference (discussing Acrobat Exchange etc...) are thus applicable here, are appreciated by the Examiner, but are unpersuasive as purely conclusory. Affidavits of unbiased experts would need to be submitted to prove such non-enablement or error by Dymetman as argued.

In the present reference, in discussing isomorphism, DYMETMAN discussed that not only Adobe PDF can bridge digital and printed documents but other description formats may provide similarly (col. 30 lines 44-47). If Applicants desire to challenge those as well, affidavits of unbiased experts would need to be submitted. DYMETMAN also discussed a digital page can be a representation of the physical coded page and can also be printed (col. 9 lines 58-60), not just displayed on a monitor as argued.

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*“Detailed Description Text - DETX (40):*

*Digital page 6 may be a digital representation (e.g. a Web page) of the printed, human-readable information in document 2, a representation that can be displayed or printed.”.*

In that case there is no technical problem with displays on screens as argued. Further, storage of page description is disclosed (see above).

To expedite prosecution, Applicants are courteously requested to consider in their entirety all the prior art cited so far during prosecution, the prior art cited below as well as prior art cited in other related applications for all that can fairly be suggested to a PHOSITA, the impact of the new Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, Federal Register / Vol. 72, No. 195 / Wednesday, October 10, 2007 / Notices, <http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf> (herein “Guidelines”) and contact the Examiner to try to determine allowable subject matter.

It has been a problem contacting the overseas Applicants by phone. A conference call with the Examiner, and at least one primary Examiner would be required for allowance, thus Applicants are courteously requested to call the Examiner at their earliest convenience. Applicants are also courteously requested to identify other applications or patents that pose potential obvious double patenting issues. Applicants are also courteously requested to double check the formal accuracy of the extensive specifications.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lazzouni 5652412 discloses pen/paper recording system.

Fleck 6689965 discloses digitizer tablet.

Irons 6952281 discloses dynamic and static content zones.

Zdybel 5486686 discloses e-domain descriptions for docs (cited by Dymetman).

Stearns 5528525 discloses decoding glyph shape codes.

Wolff 5848413 discloses accessing and publishing electronic documents.

Dymetman USPGPub 2007/0138283 citing Rhoads 6647130 and Seder 6694042,

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Dymetman US 6752317, US 6345304, Dymetman USPGPub 2002/0020750 (continuation of US 6330976 )(Effective date is 3/25/99) discloses other variations of Intelligent Paper.; Dymetman 6585163 discloses coded page ID tied to URL (col. 9 lines 50+ ; (col. 10 lines 45+).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

KHL

February 4, 2008

/James W Myhre/

Primary Examiner, Art Unit 3622